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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,893	12/19/2000	Mitsuhiko Okada	55259USA2A.005	5878

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EXAMINER

BISSETT, MELANIE D

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 11/01/2002

69

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/719,893

Applicant(s)

OKADA ET AL.

Examiner

Melanie D. Bissett

Art Unit

1711

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 October 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.


Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_.

Continuation of 2. NOTE: The amendments to claims 1 and 10 include the limitation of the heat conductive resin layer to a self-supporting adhesive, which would require further consideration by the examiner. Furthermore, the applicant has not shown support specifying the use of a self-supporting heat-conductive resin layer in the specification. The amendment to claim 3 broadens the scope of the claim by including polyester as a possible plastic film material. The added limitations to the claims do not reduce or simplify issues for appeal, since the limitations require further consideration and/or broaden the scope of the claims. Regarding the applicant's argument that Parker-Hannifin does not teach 12 microns, it is the examiner's position to interpret the reference's cited "about...0.0127-0.127 mm" to encompass 12 microns. As this is the examiner's interpretation, it would be improper for the examiner to submit an affidavit or declaration. The examiner maintains her position that, since claim 3 does not limit the substrate to a plastic film, any limitation of a plastic film would not provide patentable weight over an article with a different substrate. Regarding the applicant's arguments that a prima facie case of obviousness has not been established for added limitations describing cured coatings and release liners, it is noted that the examiner has pointed out how the cited art suggests and teaches such limitations. Since the prior art teaches such limitations, obviousness-type analysis is not needed for suggesting the claimed limitations. Since both Parker-Hannifin and Eddy are drawn to heat-conductive layers including silicone materials and heat-conductive fillers, it is the examiner's position that the references are analogous art. The examiner refers to the final rejection, paragraph 20 in response to the applicant's arguments that the abrasive nature of heat conductive fillers would preclude a reasonable expectation of success.

  
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Supervisory Patent Examiner  
Technology Center 1700